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EXAMINER

FORTUNA, JOSE A

ART UNIT	PAPER NUMBER
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1731

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/072,876
Filing Date: February 12, 2002
Appellant(s): RUF ET AL.

MAILED
FEB 23 2007
GROUP 1700

Neil F. Greenblum
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on November 13, 2006 appealing from the Office action mailed June 01, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The rejection under 35 U.S.C. §112, second paragraph has been withdrawn in view of applicants' arguments.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(8) Evidence Relied Upon

5,645,689	RUF et al.	6-1997
4,941,950	SANFORD	7-1990

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 1-53 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The phrase "integrally formed" has not been described in the specification to convey to one of the skill in the art the meaning of the phrase, i.e., what is to be considered integrally formed. Applicants state that the meaning of the phrase is found in figures 3a and 3b, but the examiner could not find/see anything on those figures that define the phrase, i.e., what structure in those figures are integrally formed?

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 11, 15, 17-23, 31, 35, 37-42, 44, and 48-50 are rejected under 35

U.S.C. 102(b) as being anticipated by Ruf et al., US Patent No. 5,645,689.

Ruf et al. teach a Multilayer headbox having at least one lamella disposed between a nozzle chamber, see abstract. Ruf et al. teach that the lamella(s) has/have upstream structure and a downstream structure. The downstream portion having first surface, a sloped portion and second surface opposed to the first surface, see figures 5-8. The figures also show the sloped part faces one of the nozzle walls. Ruf et al. teach in column 5, lines 39-44, that the nozzle walls can be provided with a deformable strip, called screen and *teach in column 4, line 64 through column 5, line 6 and shown in figure 6, that the lamella can be provided with a structure in said second surface i.e., the combination of the structure 9.6 and 8.6 of figure 6, corresponding to the sloped part of the first surface and the structure formed on said second surface respectively, and in figure 7, the top side 9.7, includes a horizontal surface and a sloped surface.* In column 6, lines 1-62, Ruf et al. teach that the headbox have a sectional consistency control, i.e., dilution water can be introduced to the headbox through sectional pipes. In column 3, lines 60-64, Ruf et al. teach that the lamella can swivel, pivotally mounted, or can be rigidly secured, fixedly mounted.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 12, 32, 46 and 51-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruf et al., (cited above) in view of Sanford, US Patent No. 4,941,950 (cited in the IDS filed on May 12, 2002).

Ruf et al. do not teach a grooved surface on the trailing elements or lamella. However, Sanford teaches that including grooves in the surfaces of the lamella/trailing elements help in the reduction of turbulence within the slice chamber, improving the paper formation, see column 3, lines 7-26 of Sanford. Therefore, adding grooves to Ruf et al. lamella as suggested by Sanford would have been obvious to one of ordinary skill in the art in order to improve paper formation.

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5. Claims 4-10, 13-14, 16, 24-30, 33-34, 36, 43 and 45-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruf et al., cited above.

Ruf et al. are silent with respect to the specific of the above claims, i.e., the angle, thickness and size of the lamella, the polymers used to make the lamella. However, it has been held that changing of size and geometric form of a device is within the levels of ordinary skill in the art absent a showing of unexpected results. It has been held that “[C]hanges in size, shape without special functional significance are not patentable. *Research Corp. v. Nasco Industries, Inc.*, 501 F2d 358; 182 USPQ 449 (CA 7), cert. denied 184 USPQ 193; 43 USLW 3359 (1974).

(10) Response to Argument

Note also that the labeling of the conclusion section is incorrect, i.e., the labels indicates part C) when it should have been part F). There are two sections with the same labels, label C).

Applicant's arguments filed on November 13, 2006 have been fully considered but they are not persuasive.

With regard to the rejection under 35 U.S.C. §112, 1st paragraph, applicants argue that the figures, specially figures 3a and 3b, reveals that the lamella is formed with only one piece, i.e., integral. This is not convincing for the following reasons:

- There is/are sufficient views of the lamella in the figures to conclude with 0% uncertainty that the lamella is formed with only one piece, i.e. only one view of the lamella is shown and the examiner cannot conclude from that view that the lamella is formed in one piece. Even though applicants argue that the meaning of the term is found in the specification, they did not point out where in the

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specification this meaning can be found. The examiner could not find such definition, implicitly or explicitly in the specification. Applicants also refer to paragraph [0064] of the specification, which states that the structure can be formed with a grooved structure as an evidence to support the meaning of “integrally formed.” Yet, this only means that the structure has grooves.

- The term integral has broader meaning than that of “formed as only one piece” as applicants argue. The term has been interpreted in its broader reasonable interpretation in view of the specification as “an essential part of the device.”

Note the dictionary definitions of the term in the advisory action mailed on August 16, 2006.

With regard to the rejections of Claims 1-3, 11, 15, 17 - 23, 31, 35, 37- 42, 44, and 48-50 Under 35 U.S.C. § 102(b) as Anticipated by RUF, applicants argue that the reference fails to teach the integrally formed structure as claimed. This has been considered unconvincing, because:

- As explained above the phrase constitute new matter and even if it wasn't the cited reference show structure in the second surface that can be considered integral to the structure, e.g., the combination of the structure 9.6 and 8.6 of figure 6, or 8.7 and 9.7 of figure 7, and therefore, the reference reads over the phrase. Note that “integral structure” has been interpreted as a structure essential to the system; see above.

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- Comparing the figures of current application and the figures of the cited reference, they seem to show the same structure and even more so, the claimed invention¹.

Regarding rejection under 35 U.S.C. §103(a) over Ruf or Sanford. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

The examiner only argues that variations of the thickness and angles and shapes of the grooves on the lamella is within the levels of ordinary skill in the art and that such designs, i.e. shapes of the grooves, including even the size of the grooves, are not only obvious, but well known in the art, see for example US Patent No. 5639,352 or US Patent No. 4,532,009, previously cited.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

¹ Note, that one thing is what it is shown in the figures and another is what is claimed.

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Conferees:

Jennifer Kolb-Michener:

A handwritten signature in cursive script, appearing to read "Jl K Michener".

Steven Griffin

A handwritten signature in cursive script, appearing to read "Steven P. Griffin".

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A handwritten signature in black ink, appearing to read "José A. Fortuna".

José A. Fortuna
Primary Examiner
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Conferees:

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